

REMARKS/ARGUMENTS

This is in response to the Final Office Action mailed March 13, 2007.

Currently pending are independent claim 38 and its dependent claims 21, 23-24, 35-37, 39-41, 50, 55-58, 61 and 63. Claims 22, 25-27, 29, 42-49, 51-54, 59-60, 62 and 64-68 have been withdrawn as being based on non-elected species.

Claim Rejections - 35 U.S.C. §103

The Examiner has rejected claims 21, 23-24, 35-41, 50, 55-58, 61 and 63 under U.S.C. § 103(a) as being unpatentable over Zemel et al., (FASEB J., 6/2000, v. 14, p. 1132) in view of Norman et al. (JBC 11/25/98, v. 508(27), p. 20022). Applicants respectfully traverse.

In view of the attached inventor Declaration under 37 C.F.R. § 1.132, it is respectfully submitted that Zemel et al., is not prior art to the invention and that the publication disclosure was derived from the work of the inventors. Second, Norman, applied without Zemel et al., does not teach or expressly or impliedly suggest any of the limitations set forth in the present claims. In addition, there is no motivation to combine Norman with other knowledge or to modify the reference to reach the claimed invention, and there would not be a reasonable expectation of success.

The Examiner asserts that Zemel et al., which has a publication date of June 2000, teaches 1-*alpha*, 25-dihydroxyvitamin D₃ induces an increase in calcium ion concentrations in adipocytes and a concomitant inhibition of lipolysis.

The present claims are entitled to the priority of Application No. 09/654,357 ("the '357 application"), filed on September 1, 2000, now U.S. Patent 6,384,087 ("the '087" patent). Present independent claim 38 is directed to a method of regulating body weight comprising administering to an individual regulating body weight an antagonist of calcitrophic hormone (1,25-(OH)₂-D) activity in an amount effective to block calcitrophic hormone (1,25-(OH)₂-D) activity in adipocytes of said

individual, said antagonist inducing weight loss, preventing weight gain and/or increasing metabolic consumption of adipose tissue. Claim 38 and its dependent claims 21, 23-24, 35-37, 39-41, 50, 55-58, 61 and 63, are fully supported in the parent '357 application. Support for these claims can be found throughout the text of the '087 patent, for example, column 2, lines 47-55, column 4, lines 13-17 and lines 23-45, and column 4, line 61-column 5, line 18.

As set forth in the attached Declaration, the Zemel et al., article is not prior art and is based on the inventors' own work. Applicants respectfully request that the rejection based on the Zemel et al., article be withdrawn. See Manual of Patent Examining Procedure, 8th ed., rev. 4, Oct. 2005, §§ 715.01(c) and 716.10.

The Examiner further asserts that Norman teaches "that 1-*beta*, 25-dihydroxyvitamin D₃ is an antagonist of the 1-*alpha* compound, particularly [sic, and] calcium ion uptake."

The present invention is distinct from Norman, which does not disclose, teach or suggest any of the elements of independent claim 38. Norman does not teach, disclose or suggest a method of regulating body weight comprising administering to an individual regulating body weight an antagonist of calcitrophic hormone (1,25-(OH)₂-D) activity in an amount effective to block calcitrophic hormone (1,25-(OH)₂-D) activity in adipocytes of said individual, said antagonist inducing weight loss, preventing weight gain and/or increasing metabolic consumption of adipose tissue, as set forth in the present claims.

The Examiner further contends that it would have been obvious to one of ordinary skill to use the 1-*beta* compound to control weight in view of Zemel. However, this contention is moot because Zemel is not prior art to the present claims and Norman does not teach or suggest controlling weight, inhibition or promotion of lipolysis or weight loss.

The Examiner contends that as to the claimed reduction in risk of coronary artery disease, one

of ordinary skill will recognize that weight loss will reduce the risk of said disease. However, this contention is moot because Zemel is not prior art to the present claims.

Further, the cited art does not disclose, teach or suggest the claimed invention as set forth in dependent claims 21, 23-24, 35-37, 39-41, 50, 55-58, 61 and 63. These include additional limitations distinguishing them from the cited references.

Claims 21, 23-24, 35-41, 50, 55-58, 61 and 63 are patentable because none of the cited references or material disclose, teach or suggest the present invention.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the allowability of claims 21, 23-24, 35-41, 50, 55-58, 61 and 63 and that the application be passed to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Please charge any necessary fees that are not included herewith or credit any overpayment to deposit account no. 22-0261.

Respectfully submitted,

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